

BoxInterferences@uspto.gov
Telephone: 571-272-4683

Paper 24
Entered: 21 February 2007

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,486 (RT)

The Trustees of
PRINCETON UNIVERSITY and
Imclone Systems Inc.
(4,882,269 and 5,424,188),
Junior Party,

v.

ENZO LIFE SCIENCES, INC.
(08/479,995),
Senior Party.

JUDGMENT - Bd. R. 127(b) - Requested

Before LEE, TORCZON, and LANE, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

- 1 The junior party has requested adverse judgment. Paper 23.
- 2 Judgment is entered AGAINST the junior party.
- 3 When the interference was declared, neither of the junior party's patents had
- 4 yet expired. See 35 U.S.C. 135(a) (limiting authority to declare an interference
- 5 with a patent to unexpired patents). On 21 November 2006, during the
- 6 interference, the 4,882,269 patent expired. Ordinarily, expiration of the involved

1 patent would prompt an order to show cause. *Lee v. Dryja*, 75 USPQ2d 1799
2 (BPAI 2004). In this case, however, the junior party had a second patent, which
3 taking Office records at face value would not expire until 21 November 2008. In
4 its request, the junior party states that the 5,424,188 patent actually also expired on
5 21 November 2006. A review of the file wrapper for the 5,424,188 patent
6 (application paper 28) confirms the junior party's statement. It is unfortunate that
7 the expiration of the 5,424,188 patent was not brought to the Board's attention
8 sooner since the delay between the expiration date of the patents and today will
9 result in an effective three-month term enhancement for the senior party.

10 At first glance, entry of judgment against the junior party might appear to be
11 moot. Since there is a theoretical possibility of estoppel, however, we have entered
12 judgment for the sake of completeness.

13 Given the advance age of the application, the 08/479,995 application file
14 shall be promptly released to the patent operations for such further action as they
15 may deem appropriate. A copy of this judgment shall be entered in the
16 administrative records of Enzo application 08/479,995 and of Princeton patents
17 4,882,269 and 5,424,188.

cc:

Thomas C. Gallagher, IMCLONE SYSTEMS, INC., with Michael N. Mercanti, LUCAS & MERCANTI, LLP, both of New York City, New York, for the Trustees of Princeton University and ImClone Systems, Inc.

Eugene C. Rzucidlo, HUNTON & WILLIAMS, LLP of New York City, New York, for Enzo Life Sciences, Inc. With him, Robert M. Schulman, HUNTON & WILLIAMS, LLP, of Washington, D.C.

Notice: Agreements and understandings regarding the termination of an interference are subject to filing requirements under 35 U.S.C. 135(c).

Notice: In the event of judicial review, note the requirements of Bd. R. 8(b).